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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,419	06/18/2001	Takasi Oonuki	14714	9624

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EXAMINER

NGUYEN, MINH CHAU

ART UNIT PAPER NUMBER

2145

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,419

Applicant(s)

OONUKI, TAKASI

Examiner

MINH-CHAU N. NGUYEN

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*MN*

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaganti et al. (Chaganti) (US 6,845,448 B1), and further in view of Katsikas (US 6868498 B1).
2. Regarding claim 1, Chaganti teaches a personal information providing system for providing personal information regarding a user through the Internet, said system comprising:
  - a personal information storer (i.e. the database 108 coupled to the server computer 100 in figure 1) configured to store an authorization key (i.e. an identifying information) for a recipient of an electronic mail (Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47); and
  - a provider (i.e. the server computer 100) for authenticating a requester using said identifying information and (i.e. the authorization key) providing the personal information regarding the user to said requester (Col. 2, L. 18-43; and Col. 5, L. 29-42; and Col. 6, L. 17-45; and Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47).

Chaganti fails to teach the personal information storer (i.e. the database 108) configured to store identifying information for a recipient of an electronic mail sent by the user. However, Katsikas, in the same field of endeavor having closely related objectivity, teaches a personal information storer (i.e. an Authorized Sender List (ASL) 203 in the email server 104) configured to store identifying information for a recipient (i.e. the recipient email addresses) of an electronic mail sent by the user (figure 1B, 2, 3A&B; and Col. 4, L. 37-55).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Katsikas's teachings of the personal information storer configured to store identifying information for a recipient of an electronic mail sent by the user, in the teachings of Chaganti in online repository for personal information, for the purpose of protecting the personal information of users by controlling the access of unknown requesters/recipients to the user's personal information.

3. Claim 5 is corresponding method claim of system claim 1. Therefore; it is rejected under the same rationale.

### ***Response to Arguments***

4. Applicant's arguments filed 05/03/06 have been fully considered but they are not persuasive.

5. Applicant's arguments toward "Robertson does not disclose whether the first user communicated by electronic mail with the second user" as well as request for reconsideration filed on 05/03/06 have been fully considered but they are moot in view of the new ground(s) of rejection.
6. Katsikas has a U.S. filing date of August 25, 2000, and it could at least go back to the provisional application No. 60/180937, filed on February 8, 2000, which is prior to June 13, 2000 (priority date of the present invention).

According from MPEP:

"Reference Publication and Patent of 35 U.S.C.111(a) Application with Priority/Benefit Claim to a Prior U.S. Provisional or Nonprovisional Application.

For reference publications and patents of patent applications filed under 35 U.S.C.111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C.111(a) application, which claims priority under 35 U.S.C.119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C.120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C.102(e), assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C.119(e) or 120".

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (571)272-4242. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JASON D. CARDONE can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Minh-Chau Nguyen  
Art Unit: 2145

MN

  
JASON CARDONE  
SUPERVISORY PATENT EXAMINER